

00862.003016



B/Image

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	:	Examiner: Charles Nolan, Jr.
TATSUO FURUKAWA ET AL.	)	
	:	Group Art Unit: 2854
Application No.: 09/374,580 ✓	)	
	:	Allowed: January 27, 2004
Filed: August 16, 1999	)	
	:	Confirmation No.: 3938
For: PRINTING HEAD, HEAD CARTRIDGE	)	
HAVING PRINTING HEAD, PRINTING	:	
APPARATUS USING PRINTING HEAD,	)	
AND PRINTING HEAD SUBSTRATE	:	June 10, 2005

**Mail Stop Issue Fee**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW HOLDING OF ABANDONMENT  
AND SECOND LETTER RE ERRONEOUS NOTICE OF ALLOWANCE

Sir:

A Notice of Abandonment issued on May 25, 2005 in the above-identified application, stating that the application has been abandoned because of Applicants' failure to timely pay the issue fee within the three-month statutory period set in the Notice of Allowance (PTOL-85) issued on January 27, 2004.

Applicants' undersigned attorney respectfully submits that the Notice of Abandonment was issued erroneously, because the Notice of Allowance in question was issued erroneously and hence the Issue Fee was not due on April 27, 2004. Rather, the Issue Fee was

timely paid in compliance with the statutory requirements therefor. The pertinent facts are as follows.

A Preliminary Amendment was filed on November 4, 2003, which amended certain claims and added certain claims.

Almost three months later, a Notice of Allowance was issued on January 27, 2004. (The total fees due in response to the Notice of Allowance were \$50, because an Issue Fee had been previously paid in response to a previous Notice of Allowance dated September 27, 2002, after which payment the application had been withdrawn from issue.)

The Notice of Allowance issued on January 27, 2004 was erroneously issued because the claims allowed therein were those that were pending in the application prior to the November 4, 2003 Preliminary Amendment. Accordingly, on February 17, 2004, Applicants filed a Letter re Erroneous Notice of Allowance (copy of same and date-stamped receipt postcard attached) explaining that the Notice of Allowance was erroneously issued and requesting examination of the Preliminary Amendment. As memorialized in the Letter re Erroneous Notice of Allowance, Applicants' representative contacted the U.S. Patent and Trademark Office (PTO) by telephone prior to filing that Letter and was told by the PTO that the Preliminary Amendment would be examined and that the application would be withdrawn from issue to do so, if necessary. On April 27, 2004, Applicants filed a further paper again requesting examination of the Preliminary Amendment (copy of same and return receipt for facsimile transmission attached). As mentioned in that paper, in further communications with the PTO Applicants' representative had been informed that the application would be withdrawn from issue for further review of Claims 59 and 64. Thus, Applicants understood that the application was being

withdrawn from issue and that the PTO acknowledged that the Notice of Allowance issued on January 27, 2004 was erroneously issued. Accordingly, no Issue Fee was due on April 27, 2004.

On November 30, 2004, Applicants received a Supplemental Notice of Allowability, indicating that the Preliminary Amendment had been considered and entered by the Examiner. Applicants did not receive a Supplemental Notice of Allowance, or any further communication from the PTO, until the instant Notice of Abandonment.

However, Applicants understand that the PTO was required to issue a Supplemental Notice of Allowance together with the Supplemental Notice of Allowability. 37 C.F.R. § 1.311. As noted above, the Notice of Allowance issued on January 27, 2004 did not allow the same set of claims allowed in the Supplemental Notice of Allowability, and additional examination on the merits occurred after issuance of the January 27, 2004 Notice of Allowance. As a result of that additional examination, the Examiner indicated that Applicants were entitled to a patent different from the one that would have issued based on the claims allowed in the January 27, 2004 Notice of Allowance. 37 C.F.R. § 1.311 states that “[i]f, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant . . . .” Since, after issuance of the Notice of Allowance on January 27, 2004, examination took place, and it was only as a result of that examination that the PTO determined that Applicants were entitled to the patent that would issue from the claims allowed in the Supplemental Notice of Allowability, it is submitted that under 37 C.F.R. § 1.311 the PTO was required to issue a Supplemental Notice of Allowance.

37 C.F.R. § 1.311 further states that “[t]he notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the

notice of allowance to avoid abandonment of the application.” Since no Supplemental Notice of Allowance was issued after issuance of the erroneously issued Notice of Allowance on January 27, 2004, no three-month period for payment of the Issue Fee was set. Accordingly, no Issue Fee was due, and no event (e.g., failure to timely pay the Issue Fee) occurred such as could legally authorize the PTO to hold the subject application abandoned.

Moreover, subsequent to Applicants’ receipt of the Supplemental Notice of Allowability, Applicants’ representative contacted the Examiner by telephone to clarify the status of the application because no Supplemental Notice of Allowance had been received. The Examiner indicated that he believed the application was being passed to issue. During the telephone conference, Applicants called the Examiner’s attention to the \$50 balance of the Issue Fee due, and the Examiner recommended that Applicants file a Letter Authorizing Charge of Deposit Account for Balance of Issue Fee within three months of the issue date of the Supplemental Notice of Allowability. Applicants duly filed such a Letter on February 25, 2005, authorizing the PTO to charge the \$50 balance of the Issue Fee.

Thus, Applicants were made to understand by the Examiner that his intention had been to issue a Supplemental Notice of Allowance, that he considered the Supplemental Notice of Allowability to function as a Supplemental Notice of Allowance, and that the application would pass to issue upon payment of the \$50 balance of the Issue Fee within three months of the issue date of the Supplemental Notice of Allowability.

Moreover, according to the Image File Wrapper of the subject application as accessed by Applicants’ undersigned attorney using PAIR, the Supplemental Notice of Allowability issued on November 30, 2004 is characterized as a “Notice of Allowance and Fee(s)

Due (PTOL-85)” (see attached copy of the table of contents from the Image File Wrapper).

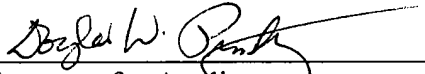
Accordingly, Applicants understand that the PTO deemed the Supplemental Notice of Allowability to be a Supplemental Notice of Allowance, and deemed the balance of the Issue Fee to be due three months after the issue date of the Supplemental Notice of Allowability, namely, on February 28, 2005. Since Applicants paid the balance of the Issue Fee on February 25, 2005, Applicants submit that, even if the Issue Fee were due three months after the issue date of the Supplemental Notice of Allowability, it was timely paid by Applicants. Since the Issue Fee has been timely paid, Applicants submit that the Notice of Abandonment was issued erroneously.

In conclusion, in view of the facts as set forth above, Applicants submit that the Notice of Abandonment was erroneously issued, because Applicants timely paid the Issue Fee. Since the Notice of Allowance dated January 27, 2004 was issued erroneously, because it failed to take into account the Preliminary Amendment (timely filed on November 4, 2003), no Issue Fee was due on April 27, 2004. Moreover, even had a fee been due, Applicants’ representative was informed that the application was being withdrawn from issue and, in fact, the application was withdrawn from issue for further substantive examination. Insofar as the balance of the Issue Fee could properly be deemed to have been due three months after the issue date of the Supplemental Notice of Allowability (i.e., on February 28, 2005), the balance of the Issue Fee due was paid by that date.

Accordingly, Applicants respectfully request that the Commissioner withdraw the erroneously issued Notice of Abandonment and the erroneously issued Notice of Allowance, and promptly pass the subject application to issue.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

  
\_\_\_\_\_  
Attorney for Applicants  
Douglas W. Pinsky  
Registration No. 46,994

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200  
DWP/tmc

DC\_MAIN 205496v1



Commissioner for Patents

P.O. Box 1450  
Alexandria, VA 22313-1450

Date 02, 16, 04  
Mo. Day Yr.  
Atty. Docket 00862-003016  
Application No. 09/374,580

Sir:

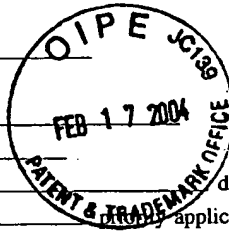
Kindly acknowledge receipt of the accompanying:

- ☐ Response to Official Action. \_\_\_\_\_
- ☐ Check for \$ \_\_\_\_\_ (claims fee)
- ☐ Petition under 37 CFR 1.136 and Check for \$ \_\_\_\_\_
- ☐ Notice of Appeal and Check for \$ \_\_\_\_\_
- ☐ Information Disclosure Statement, PTO-1449 and \_\_\_\_\_ documents
- ☐ Claim for priority and certified copies of \_\_\_\_\_ applications
- ☐ Issue fee transmittal and Check for \$ \_\_\_\_\_

☒ Other (specify) Letter re: Erroneous Notice of Allowance  
by placing your receiving date stamp hereon and returning to deliverer.

Atty. JAK/ih

Due Date 04, 27, 04  
Mo. Day Yr.



For 0-00

BEST AVAILABLE COPY

00862.003016



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	:	Examiner: Charles Nolan, Jr.
TATSUO FURUKAWA ET AL.	)	
	:	Group Art Unit: 2854
Application No.: 09/374,580	)	
	:	
Filed: August 16, 1999	)	
	:	
For: PRINTING HEAD, HEAD	)	
CARTRIDGE HAVING	:	
PRINTING HEAD,	)	
PRINTING APPARATUS	:	
USING PRINTING HEAD,	)	
AND PRINTING HEAD	:	
SUBSTRATE	)	February 13, 2004

Commissioner for Patents

LETTER RE ERRONEOUS NOTICE OF ALLOWANCE

Sir:

A Notice of Allowance was issued in the above-identified application, on January 27, 2004, but the claims which were allowed were those that existed in the application prior to the Preliminary Amendment dated November 4, 2003, which was duly filed on that day via Certificate of mail.

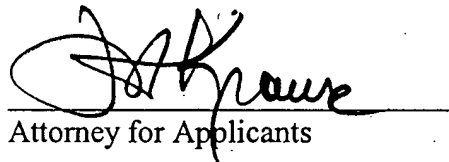
This error was pointed out to the Examiner who recommended that the undersigned contact the PTO at (571) 272-1576. That call was made and the authorities stated that the Preliminary Amendment was in fact received by the PTO and that it would be found and combined with the file.

In this regard, for the convenience of the PTO, attached is a copy of the November 4, 2003, Preliminary Amendment, and a photocopy of the return Postcard indicated that the Preliminary Amendment was duly received by the PTO on November 10, 2003.

It is respectfully requested that the Preliminary Amendment claims be examined prior to the due date of April 27, 2004, for paying the Issue Fee.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

  
Attorney for Applicants

Registration No. 24,613

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

NY\_MAIN 408146v1

## Auto-Reply Facsimile Transmission



TO:

Fax Sender at 1212 218 4561

Fax Information:

Date Received:

4/27/2004 5:01:28 PM [Eastern Daylight Time]

Total Pages:

3 (including cover page)

**ADVISORY:** This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received  
Cover  
Page  
=====>

04/27/2004 17:01 FAX 1212 218 4561

FITZPATRICK N.Y.

0001

### FITZPATRICK, CELLA, HARPER & SCINTO

30 Rockefeller Plaza  
New York, NY 10112-3801  
(212) 218-2100

Facsimile: (212) 218-2200

#### FACSIMILE COVER SHEET

TO:	Charles Nolan, Jr. U.S. Patent and Trademark Office	
FROM:	John A. Krause	
RE:	U.S. Patent Application No. 09/374,580 Atty. Docket: 00862.003016	
FAX NO.:	1-703-872-9306	
DATE:	April 27, 2004	NO. OF PAGES: 3 (including cover page)
TIME:	SENT BY:	

#### MESSAGE

IF YOU DO NOT RECEIVE ALL THE PAGES  
PLEASE CALL 212-218-2100 AS SOON AS POSSIBLE.

Note: We are transmitting from a Canon Model FAX-L770  
(compatible with any Group I, Group II or Group III machine).

THIS FACSIMILE MESSAGE AND ACCOMPANYING DOCUMENTS ARE INTENDED ONLY FOR THE USE OF THE ADDRESSEE INDICATED ABOVE. INFORMATION THAT IS PRIVILEGED OR OTHERWISE CONFIDENTIAL MAY BE CONTAINED THEREIN. IF YOU ARE NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, REVIEW OR USE OF THIS MESSAGE, DOCUMENTS OR INFORMATION CONTAINED THEREIN IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS MESSAGE IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE OR FACSIMILE AND MAIL THE ORIGINAL TO US AT THE ABOVE ADDRESS. THANK YOU.

RECEIVED

APR 27 2004

FITZPATRICK, CELLA, HARPER & SCINTO

00862.003016

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	:	Examiner: Charles Nolan, Jr.
TATSUO FURUKAWA ET AL.	)	
	:	Group Art Unit: 2854
Application No.: 09/374,580	)	
	:	
Filed: August 16, 1999	)	
	:	
For: PRINTING HEAD, HEAD	)	
CARTRIDGE HAVING	:	
PRINTING HEAD,	)	
PRINTING APPARATUS	:	
USING PRINTING HEAD,	)	
AND PRINTING HEAD	:	
SUBSTRATE	)	April 27, 2004

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450


LETTER RE WITHDRAWAL OF APPLICATION  
FROM ISSUE PURSUANT TO MPEP §714.15

Sir:

A Request for Continued Examination was filed in the above-identified application on August 4, 2003, followed by the filing of a Preliminary Amendment on November 4, 2003, by means of which additional claims were filed.

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 703-872-9306) on

April 27, 2004

	John A. KRAUSE
	(Name of Attorney for Applicant)
Signature	April 27, 2004

A Notice of Allowance was issued on January 27, 2004, but that Notice did not refer to the claims of the Preliminary Amendment which had been filed almost three months earlier.

In response to inquiries made to the Patent and Trademark Office, the undersigned was informed that the Preliminary Amendment would be found and reviewed.

The undersigned has now been informed that Claims 59 and 64 must be reviewed further before they can be allowed. Accordingly, pursuant to MPEP §714.15, the Issue Fee is not being paid today, with the understanding that the application will be withdrawn from issue for further examination.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

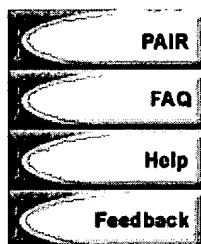
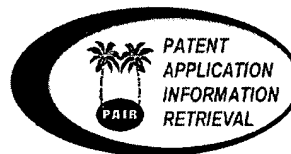
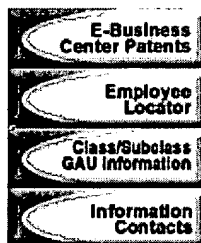
Respectfully submitted,



Attorney for Applicants

Registration No. 24613

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200


**United States Patent and Trademark Office**
[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)
**PATENT APPLICATION INFORMATION RETRIEVAL**

**Other Links**

**Image File Wrapper for Application No.:09/374,580**

NET

This application is officially maintained in electronic form. To View: Click the desired Document Description and click Download.

Mail Room Date	Document Description	Document Category
05/25/2005	Abandonment	PROSECUTION
02/25/2005	Miscellaneous Incoming Letter	PROSECUTION
02/10/2005	Issue Information including classification, examiner, name, claim, renumbering, etc.	PROSECUTION
02/10/2005	Index of Claims	PROSECUTION
02/10/2005	Internal Response to Printer Query from TC	PROSECUTION
12/03/2004	Printer Query form, used by Office of Publications	PROSECUTION
11/30/2004	Notice of Allowance and Fees Due (PTOL-85)	PROSECUTION
10/28/2004	Miscellaneous Incoming Letter	PROSECUTION
04/27/2004	Miscellaneous Incoming Letter	PROSECUTION
02/17/2004	Amendment after Notice of Allowance (Rule 312)	PROSECUTION
02/17/2004	Preliminary Amendment	PROSECUTION
02/17/2004	Claims	PROSECUTION
02/17/2004	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION
02/17/2004	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION
02/17/2004	Claims	PROSECUTION
02/17/2004	Amendment - After Non-Final Rejection	PROSECUTION
02/17/2004	Miscellaneous Incoming Letter	PROSECUTION
01/27/2004	Notice of Allowance and Fees Due (PTOL-85)	PROSECUTION
01/27/2004	List of References cited by applicant and considered by examiner	PRIOR ART
12/10/2003	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION
12/10/2003	Claims	PROSECUTION
12/10/2003	Preliminary Amendment	PROSECUTION

08/04/2003	Petition Entered	PROSECUTION
08/04/2003	Foreign Reference	PRIOR ART
08/04/2003	Foreign Reference	PRIOR ART
08/04/2003	Foreign Reference	PRIOR ART
08/04/2003	Information Disclosure Statement (IDS) Filed	PROSECUTION
08/04/2003	Petition Decision	PROSECUTION
08/04/2003	Request for Continued Examination (RCE)	PROSECUTION
06/04/2003	Miscellaneous Action with SSP	PROSECUTION
04/16/2003	List of References cited by applicant and considered by examiner	PRIOR ART
04/16/2003	Miscellaneous Action with SSP	PROSECUTION
02/20/2003	Petition Decision	PROSECUTION
02/03/2003	Foreign Priority Papers Filed	PROSECUTION
02/03/2003	Miscellaneous Incoming Letter	PROSECUTION
02/03/2003	Foreign Priority Papers Filed	PROSECUTION
02/03/2003	Foreign Priority Papers Filed	PROSECUTION
01/07/2003	Miscellaneous Incoming Letter	PROSECUTION
01/07/2003	Foreign Priority Papers Filed	PROSECUTION
01/07/2003	Foreign Priority Papers Filed	PROSECUTION
01/07/2003	Foreign Priority Papers Filed	PROSECUTION
12/13/2002	Internal Response to Printer Query from TC	PROSECUTION
11/13/2002	Internal Response to Printer Query from TC	PROSECUTION
10/15/2002	NPL Documents	PRIOR ART
10/15/2002	Foreign Reference	PRIOR ART
10/15/2002	Foreign Reference	PRIOR ART
10/15/2002	Foreign Reference	PRIOR ART
10/15/2002	Foreign Reference	PRIOR ART
10/15/2002	Foreign Reference	PRIOR ART
10/15/2002	Foreign Reference	PRIOR ART
10/15/2002	Foreign Reference	PRIOR ART
10/15/2002	Foreign Reference	PRIOR ART
10/15/2002	Foreign Reference	PRIOR ART
10/15/2002	Information Disclosure Statement (IDS) Filed	PROSECUTION
10/15/2002	Miscellaneous Incoming Letter	PROSECUTION
10/15/2002	Foreign Reference	PRIOR ART

09/27/2002	Notice of Allowance and Fees Due (PTOL-85)	PROSECUTION
09/27/2002	List of References cited by applicant and considered by examiner	PRIOR ART
07/26/2002	Foreign Reference	PRIOR ART
07/26/2002	Foreign Reference	PRIOR ART
07/26/2002	Foreign Reference	PRIOR ART
07/26/2002	Foreign Reference	PRIOR ART
07/26/2002	Foreign Reference	PRIOR ART
07/26/2002	Foreign Reference	PRIOR ART
07/24/2002	Amendment - After Non-Final Rejection	PROSECUTION
07/24/2002	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION
07/24/2002	Miscellaneous Incoming Letter	PROSECUTION
05/22/2002	Amendment - After Non-Final Rejection	PROSECUTION
04/23/2002	List of References cited by applicant and considered by examiner	PRIOR ART
04/23/2002	Non-Final Rejection	PROSECUTION
02/14/2002	Information Disclosure Statement (IDS) Filed	PROSECUTION
02/04/2002	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION
02/04/2002	Claims	PROSECUTION
02/04/2002	Amendment - After Non-Final Rejection	PROSECUTION
08/27/2001	Non-Final Rejection	PROSECUTION
08/27/2001	List of References cited by applicant and considered by examiner	PRIOR ART
06/14/2001	Miscellaneous Incoming Letter	PROSECUTION
05/08/2001	Non-Final Rejection	PROSECUTION
05/07/2001	Information Disclosure Statement (IDS) Filed	PROSECUTION
03/05/2001	Miscellaneous Incoming Letter	PROSECUTION
03/05/2001	Applicant Arguments or Remarks Made in an Amendment	PROSECUTION
03/05/2001	Claims	PROSECUTION
03/05/2001	Amendment - After Non-Final Rejection	PROSECUTION
03/05/2001	Drawings	PROSECUTION
08/30/2000	List of references cited by examiner	PRIOR ART
08/30/2000	Non-Final Rejection	PROSECUTION
10/27/1999	Miscellaneous Incoming Letter	PROSECUTION
10/27/1999	Oath or Declaration filed	PROSECUTION

08/31/1999	Miscellaneous Action with SSP	PROSECUTION
08/16/1999	Miscellaneous Incoming Letter	AS FILED
08/16/1999	Fee Worksheet (PTO-875)	PROSECUTION
08/16/1999	Fee Worksheet (PTO-875)	PROSECUTION
08/16/1999	Oath or Declaration filed	PROSECUTION
08/16/1999	Abstract	PROSECUTION
08/16/1999	Claims	PROSECUTION
08/16/1999	Specification	PROSECUTION
08/16/1999	Drawings	PROSECUTION
08/16/1999	Transmittal letter	PROSECUTION
08/16/1999	Index of Claims	PROSECUTION
08/16/1999	Search information including classification, databases and other search related notes	PROSECUTION
08/16/1999	Issue Information including classification, examiner, name, claim, renumbering, etc.	PROSECUTION

Sorted By : Mail Room Date

---

[|.HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)